



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/730,823	12/07/2000	Noriaki Kudo	108062	8607

7590

01/22/2003

Oliff & Berridge PLC  
P.O. Box 19928  
Alexandria, VA 22320

EXAMINER

RIBAR, TRAVIS B

ART UNIT

PAPER NUMBER

1711

9

DATE MAILED: 01/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/730,823

Applicant(s)

KUDO ET AL.

Examiner

Travis B Ribar

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 1-6 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of group 2 (claim 7) and the species represented by structure 1B in Paper No. 7 is acknowledged. The traversal is on the ground(s) that the groups are not separate and a search for one group would be the same search used for the other group. This is not found persuasive because the inventions are not suitably similar enough that a search for one would necessarily include a search for the other. The applicant acknowledges the intermediate-final product relationship between the groups.

The requirement is still deemed proper and is therefore made FINAL.

2. Newly submitted claim 7 contains compounds directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the 4<sup>th</sup>, 6<sup>th</sup>, 8<sup>th</sup>, and 11<sup>th</sup> imidazolyl compounds listed in claim 7 do not belong to the originally elected species.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, these parts of claim 7 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Art Unit: 1711

***Oath/Declaration***

3. The newly submitted Declaration is sufficient to overcome the objection put forth in the office action dated May 15, 2002.

***Claim Rejections - 35 USC § 102***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 7 and 9-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Hashimoto et al.

The office action dated May 15, 2002 contains text of the rejection and how it is applicable to original claim 7. Regarding the amendment to claim 7, the imidazolyl compounds in the reference (column 13, lines 43-46) do include the same compounds the applicant now claims in claim 7. Further, the aromatic diamines (column 9, lines 34-65) and the dianhydrides (column 8, line 59 to column 9, line 5) in Hashimoto et al. meet the restrictions of newly added claims 9 and 10.

***Claim Rejections - 35 USC § 103***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Art Unit: 1711

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto et al. in view of Sattler.

Hashimoto et al. uses the applicant's claimed imidazolyl compound as a reaction promoter, but does not explicitly state the amount of compound present in the composition. It is well known in the art to use reaction promoters in amounts within the range the applicant claims in claim 8. For example, Sattler discloses such a relationship (see the examples), where IPT is used as a reaction promoter in a polyimide composition.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the reaction promoter in Hashimoto et al. in an amount within the range of the applicant's claim 8. The motivation for doing so would be to promote the reaction in Hashimoto et al. Therefore it would have been obvious to combine the knowledge found in Sattler with Hashimoto et al. to obtain the invention as specified in claim 8.

8. Claims 7 and 9-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneko et al. in view of Hashimoto et al.

The office action dated May 15, 2002 contains text of the rejection and how it is applicable to original claim 7. The use of Hashimoto et al. in light of the newly added limitations of claim 7 is addressed above. Regarding newly added claims 9 and 10, the polyimide in Kaneko et al. is made from diamines (column 9, lines 33-34) and dianhydrides (column 5, lines 46-47) meeting the restrictions of claims 9 and 10.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the reaction promoter and production process in Hashimoto et al. with the polyimide composition in Kaneko et al. The motivation for doing so would be to aid the progress of the synthesis of the polyimide and to create a suitable flexible printed board. Therefore it would have been obvious to combine Hashimoto et al. with Kaneko et al. to obtain the invention as specified in claims 7 and 9-10.

9. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaneko et al. in view of Hashimoto et al. as applied to claim 7 above, and further in view of Sattler.

The combined teachings of Hashimoto et al. and Kaneko et al. use the applicant's claimed imidazolyl compound as a reaction promoter, but do not explicitly state the amount of compound present in the composition. It is well known in the art to use reaction promoters in amounts within the range the applicant claims in claim 8. For example, Sattler discloses such a relationship (see the examples), where IPT is used as a reaction promoter in a polyimide composition.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to use the reaction promoter disclosed by Hashimoto et al. in an amount within the range of the applicant's claim 8. The motivation for doing so would be to promote the reaction of the product taught by the combination of Kaneko et al. and Hashimoto et al. Therefore it would have been obvious to combine the knowledge found in Sattler with Hashimoto et al. and Kaneko et al. to obtain the invention as specified in claim 8.

***Response to Arguments***

10. Applicant's arguments with respect to claim 7 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Travis B Ribar whose telephone number is (703) 305-3140. The examiner can normally be reached on 8:30-5:00 Monday through Friday.

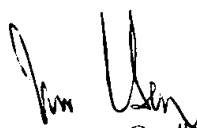
Art Unit: 1711

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (703) 308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

Travis B Ribar  
Examiner  
Art Unit 1711

TBR  
January 14, 2003

  
James J. Seidleck  
Supervisory Patent Examiner  
Technology Center 1700